

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q92718

Haruo IMAWAKA, et al.

Appln. No.: 10/564,720

Group Art Unit: 1621

Confirmation No.: 1473

Examiner: Paul A. Zucker

Filed: January 17, 2006

For: BRANCHED CARBOXYLIC ACID COMPOUND AND USE THEREOF

PETITION TO WITHDRAW FINALITY
UNDER 37 C.F.R. § 1.181

ATTN: Technology Director
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit that the final Office Action dated April 15, 2008, improperly has been made final and thus respectfully solicits withdrawal of the finality of the Office Action.

Specifically, the Examiner sets forth at least one new ground of rejection which was not necessitated by Applicants' amendments nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. §1.97(c) with the fee set forth in 37 C.F.R. §1.17(p). See MPEP § 706.07(a).

Namely, the Examiner has newly rejected claim 19 for lack of enablement under 35 U.S.C. §112, 1st paragraph, and has made the Action final. This new §112, 1st paragraph rejection is a new ground of rejection, which is neither necessitated by amendment nor is it based on information submitted in an information disclosure statement filed during the period set forth

in 37 C.F.R. § 1.97(c) with the fee required in 37 C.F.R. § 1.17(p). This contravenes current practice. The MPEP states that under current U.S. PTO practice, second or any subsequent actions on the merits shall be final, **except** where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. §1.97(c) with the fee set forth in 37 C.F.R. §1.17(p). See MPEP § 706.07(a).

The Examiner recognizes that the §112, 1st paragraph rejection is a new ground of rejection, and states that claim 19 was omitted from the previous enablement rejection in the Action dated September 13, 2007 due to clerical error. The Examiner further asserts that Applicants should have recognized that claim 19 should have been included in the §112, first paragraph, enablement rejection because the same limitations were addressed in the rejection of claims 11-18.

Applicants disagree with the Examiner's position on raising a new ground of rejection and making the Action final. Although the Examiner states that claim 19 was omitted from the previous enablement rejection in the Action dated September 13, 2007 due to clerical error, it remains that claim 19 was not rejected in the previous Action and the present rejection of claim 19 is a new ground of rejection that was not necessitated by Applicants' amendment. Additionally, canceled claims 11-16 were directed to an agent and canceled claims 17-18 were directed to a medicament, while claim 19 is directed to a method for preventing and/or treating a neurodegenerative disease. Thus, it was not unreasonable to consider that the Examiner would treat the different types of claims in a different manner.

In view of the above, since Applicants are limited in the action that can be taken after a final rejection as a matter of right, Applicants submit that making the rejection final is improper as a procedural matter for the reasons set forth above. Namely, that the Examiner has raised a new ground of rejection that is neither: (1) necessitated by Applicants' Amendment, nor (2) based on information submitted in an information disclosure statement requiring a fee under 37 C.F.R. § 1.17(p).

For the reasons discussed above, Applicants request that the finality of the Office Action be withdrawn.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

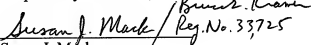
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Date: June 13, 2008

Respectfully submitted,


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